

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed June 27, 2006.

Currently, claims 1-26 are pending. Applicants have amended claims 1-6, 8, 12-15, 18, 20 and 23-26. Applicants respectfully request reconsideration of claims 1-26.

I. Summary of the Examiner's Objections and Rejections

Claims 1, 4, 5, 6, 8, 12, 14, 15, 18, 20, and 24-26 were objected to because they contain informalities.

Claims 14, 20, and 24-26 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 5, 13, 18, 20, and 24-26 were rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicant regards as their invention.

Claims 1-26 were rejected under 35 U.S.C. 103 (a) as being unpatentable over *Loveland* (U.S. Patent No. 6,826,539 B2) in view of *Hsu et al.* (U.S. Patent No. 6,574,644 B2).

II. Summary of the Amendments

Applicant has amended claims 1-6, 8, 12-15, 18, 20 and 23-26.

III. Objections to the Claims

Claims 1, 4, 5, 6, 8, 12, 14, 15, 18, 20, and 24-26 were objected to because they contain informalities.

Claims 1, 4, 5, 20, 23 and 24 were objected to because they recite “for storage” or “for storing.” The Examiner indicated this is an intended use recitation and carries no patentable weight. For purposes of expediting prosecution, Applicant has amended claim 1 to correct a “transmitting [...] to the database for storage as a data unit” to “transmitting as a data unit [...] to the database.” Applicant has removed the language “for storage” from claims 4, 5, 20, 23 and 24. Applicant asserts that this objection is now moot.

Claims 1, 5, 14, 20 and 24 were objected to because they recite “configured for” which

Examiner asserted was an intended use recitation. For purposes of expediting prosecution, Applicant has amended claims 1, 5, 14, 20 and 24 to change the language “configured for” to recite “configured to.” Applicant asserts that this objection is now moot.

Claim 18 was objected to because it recites “data base,” which should be one word. Application has amended claim 18 to recite “data base” as one word. Applicant asserts that this objection is now moot.

Claim 6 was objected to because it recites “can be” with respect to creating a link. Examiner indicated this is passive and carries no patentable weight. For purposes of expediting prosecution, Applicant has amended claim 6 to recite “the database configured to create the link.” Applicant asserts that this objection is now moot.

Claims 20 and 24-26 were objected to because they recite “to enable” or “enabling” in the preamble. The Examiner indicates that this language is passive and has no patentable weight. For purposes of expediting prosecution, Applicant has amended the preambles of claims 20 and 24-26 to recite “A memory storing instructions for instructing a processor to perform a method by a first computer system,” thus removing the language of “to enable.” Applicant asserts that this objection is now moot.

Claims 1, 5, 6, 14, 20 and 24 were objected to because they contained an element “a second component specification and CAD element” that lacked antecedent basis. Applicant has amended claims 1, 5, 6, 14, 20 and 24 to recite “the second component specification and CAD element” to correct the improper antecedent basis for these elements. Applicant asserts that this objection is now moot.

Claim 1 was objected to because the elements “a component specification” and “a non-physical and non-functional attribute” lack proper antecedent basis. Applicant amended claim 1 to recite “the first component specification” and “the non-physical and non-functional attribute” to correct the improper antecedent basis for these elements. Applicant asserts that these objections are now moot.

Claim 8 was objected to because the element “a computer system” lacks proper antecedent basis. Applicant amended claim 8 to recite “the computer system” to correct the improper antecedent basis for this element. Applicant asserts that this objection is now moot.

Claim 12 was objected to because the element “a monitor” lacks proper antecedent basis. Applicant amended claim 12 to recite “the monitor” to correct the improper antecedent basis for this element. Applicant asserts that this objection is now moot.

Claim 15 was objected to because the element “a physical or a functional attribute” lacks proper antecedent basis. Applicant amended claim 15 to recite “the physical or the functional attribute” to correct the improper antecedent basis for this element. Applicant asserts that this objection is now moot.

IV. Rejection Under 35 U.S.C. § 101

Claims 14, 20, and 24-26

The Examiner indicated claims 14, 20 and 24-26 are rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. In particular, the Examiner indicated that claim 14 recites “processor readable code for” performing a functionality without mentioning the “processor” executing or processing the code and the recitation of “for” does not cause any functionality to occur in the processor. Application respectfully traverses this rejection.

The preamble for claims 14 recites:

One or more processor readable storage devices having processor readable code embodied on said processor readable storage devices, said processor readable code for programming a processor to perform a method comprising.

The preamble of claim 14 recites one or more processor readable storage devices which have processor readable code for programming “a processor” to perform a method. The processor readable code programs the processor to perform the method of claim 14. Thus, claim 14 recites a processor which is programmed by processor readable code.

With respect to containing the word “for” in claim 14, Applicant asserts that the claim format is proper because claim 14 is directed to “processor readable code” contained on “one or more processor readable storage devices.” Claims that are directed to computer programs embodied in a tangible medium, such as a floppy diskette, are patentable subject matter under 35 U.S.C. 101. (*In re Beauregard*, 53 F.3d 1583, 1484 (Fed. Cir. 1995)). There is no requirement that a “Beauregard”

claim recite functionality to occur in the processor. Claim 14 is directed to a tangible medium of “One or more processor readable storage devices,” not a processor. Claim 14 recites a preamble wherein computer programs in the form of code are embodied on “the processor readable storage devices” for programming a processor. Thus, claim 14 is in the proper format of a “Beauregard” claim and contains patentable subject matter

Because claim 14 recites that processor readable code is used for programming a processor and recites the processor readable code is embodied on a tangible medium of “One or more processor readable storage devices” as required for a Beauregard claim, Applicant asserts that claim 14 is directed to statutory subject matter and requests the objection be withdrawn.

The preamble for claim 20 recites:

A memory storing instructions for instructing a processor to perform a method by a first computer system, the method comprising.

The preamble of claim 20 recites instructions for instructing “a processor” to perform a method. The processor readable code stored in the memory programs the processor to perform the functionality of the method of claim 14.

Applicant asserts that claim 20 is directed to patentable subject matter because it recites that “instructions” are stored on a tangible medium of “memory.” Claims that are directed to computer programs embodied in a tangible medium, such as a floppy diskette, are patentable subject matter under 35 U.S.C. 101. (*In re Beauregard*).

Because claim 20 recites that processor readable code is used to program a processor and that instructions are stored in a tangible medium of “memory,” Applicant asserts that claim 14 is directed to statutory subject matter and requests the rejection of claim 20 under 35 USC 101 be withdrawn. Claims 24-26 have the same preamble of claim 20. Therefore, Applicant requests the rejection under 35 USC 101 be withdrawn for claims 24-26 as well.

Claims 6 and 18

The Examiner indicated claims 6 and 18 are rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. In particular, the Examiner indicated

that claims 6 and 18 do not recite a practical application by producing a physical transformation or producing a useful, concrete and tangible result.

For purposes of expediting prosecution, Applicant amended claims 6 and 8 to recite “creating and storing a link.” “Storing a link” is a practical application because the link is available for subsequent use. Applicant respectfully asserts that the rejection under 35 USC 101 for claims 6 and 18 be withdrawn.

V. Rejection Under 35 U.S.C. § 112, second paragraph

Claims 1, 5, 13, 18, 20 and 24-26

Claims 1, 5, 13, 18, 20 and 24-26 were rejected under 35 USC 112, second paragraph, as failing to set forth the subject matter that Applicant regarded as their invention. In particular, Examiner indicated that language of “capable of” or “able to” is not prohibiting and does not cause any functionality to occur in a computer.

For purposes of expediting prosecution, Applicant has amended claims 1, 5, 13, 18, 20 and 24-26 to replace the language of “capable of” and “able to” with “configured to.” Applicant asserts that these claims set forth the subject matter regarded as Applicant’s invention and requests the rejection of claims 1, 5, 13, 18, 20 and 24-26 under 35 USC 112, second paragraph, be withdrawn.

Claim 2

Claim 2 was rejected under 35 USC 112, second paragraph, because it recites “the first graphical element comprises a first CAD graphical element” while claim 1 recites “a first graphical element comprising a CAD element, area or sub area,” thereby confusing the Examiner regarding the scope of claim 2. Applicant has amended claim 2 to recite that “the CAD element is a first CAD graphical element, the first graphical element comprising the first CAD graphical element.” Applicant submits that the scope of claim 2 is now clear and requests the rejection under 35 USC 112, second paragraph, be withdrawn.

Claim 25-26

Claim 25-26 was rejected under 35 USC 112, second paragraph, because there is no antecedent basis for “in response to information received” as recited in claims 25 and 26. Applicant has amended claims 25 and 26 to recite, “in response to the first non-graphical data element, first graphical element data or second graphical data unit stored in the database.” This amendment clarifies the each of claims 25 and 26 and provides the claims with proper antecedent basis. Applicant requests the rejection under 35 USC 112, second paragraph, be withdrawn for claims 25-26.

VI. Rejection Under 35 U.S.C. § 103 (a) under Loveland and Hsu

Examiner rejected claims 1-26 under 35 USC §103(a) as being unpatentable over United States Patent No. 6,826,539 B2 (*Loveland*) in view of United States Patent No. 6,574,644 (*Hsu*). Because *Loveland* in view of *Hsu* fails to teach or suggest each limitation of claims 1-26, applicant asserts that claims 1-26 are patentable over the cited art.

Among other limitations, claim 1 recites:

displaying a graphical user interface on the monitor of the first computer system, wherein the graphical user interface is configured to:

- receive non-graphical information associated with the first graphical element including a first component specification, and
 - link information for at least one component specification to a second component specification and the CAD element, area or sub-area, the at least one component specification including the first component specification;*
- entering the first component specification into the graphical interface, the first component specification comprising at least one non-graphical data element representing a physical or functional attribute and at least one data element representing a non-physical and non-functional attribute into the graphical user interface; and
 - the first computer system transmitting said component specification including the non-graphical data element and said data element representing the non-physical and non-functional attribute as a data unit to a database for storage via internet communication.*

Loveland discloses a system for electronically storing a model which communicates the attributes of a structure along with related information. (col. 4, lines 61-67) The related information is stored according to document type. For example, “inventory items are ... stored according to the item type and information type.” (col. 15, lines 56-65) Graphical information in the form of an image may be stored and linked to the model. (col. 8, lines 7-10)

Loveland does not disclose “displaying a graphical user interface” that is configured to “link information for at least one component specification to a second component specification **and** a CAD element, area or sub-area,” as recited in claim 1. (Office Action, page 9, first paragraph)

The claimed embodiment recites that the graphical user interface can be used to link a component specification to a CAD element, area or sub-area and a second component specification. *Loveland* does not describe a “graphical user interface” configured to link a component specification to both a second component specification and a CAD element. *Loveland* does not disclose linking component specifications to each other at all. Unlike the claimed embodiment of claim 1, *Loveland* discloses processing files individually.

Hsu fails to cure the deficiencies of *Loveland* when taken alone or combined therewith. *Hsu* discloses generating a hyperlink between two documents. The hyperlink is generated by a link editor in response to selecting an anchor in a source document and a destination object in a destination document. (col. 3, lines 67 to col. 4, line 9)

Hsu does not disclose a graphical user interface that is configured to “link information for at least one component specification to a second component specification and the CAD element, area or sub-area.” *Hsu* relates to generating hyperlinks, and therefore teaches away from linking a component specification to two items. A source object cannot be linked to more than one item using a hyperlink; a hyperlink connects one source object to one destination object. Further, *Hsu* does not disclose linking “component specifications.” Rather, *Hsu* links individual objects comprised of a text pattern or a graphical object such as an image. *Hsu* does not disclose linking “component specifications” that contain two data elements.

For the reasons discussed above, the combination of *Loveland* and *Hsu* fails to teach or suggest each limitation of the embodiment claimed in claim 1. Because the combination of *Loveland* and *Hsu* fails to teach or suggest each limitation of claim 1, Applicant asserts that claim 1 is patentable over the cited art under 35 USC 103(a). Independent claims 5, 14, 20, 24 contain the distinguishing “linking” feature as recited in claim 1. Independent claims 6, 18, 25 and 26 recite the linking feature from a database perspective. In particular, these independent claims recite that a database may link a component specification to both another component specification and a CAD element (or graphical data element). For these reasons, Applicants submit that *Loveland* in view of

Hsu does not disclose or suggest the embodiments claimed in claims 5-6, 14, 18, 20 and 24-26. Dependent claims 2-4, 7-13, 15-17, 19 and 21-23 depend from patentable claims 1, 5, 6, 14, 18, 20, and 24-26, and should be patentable for at least these reasons in addition to the distinguishing limitations they recite.

Loveland also does not disclose the recited limitation of “*transmitting said component specification [...] as a data unit to a database,*” wherein the component specification “comprises at least one non-graphical data element representing a physical or functional attribute and at least one data element representing a non-physical and non-functional attribute.” Rather than transmitting multiple data elements (which comprise a component specification) as one “data unit,” *Loveland* discloses storing data entries individually. In particular, data entries in *Loveland* are processed and stored by type in separate files. (col. 15, lines 56-65) Unlike the embodiment recited in claim 1, multiple data elements in *Loveland* are transmitted individually. As a result, the system of *Loveland* does not transmit more than one data entry as one unit and therefore is less efficient and handles data differently than the embodiment as claimed in claim 1.

Hsu fails to cure the deficiencies of *Loveland* when taken alone or combined therewith. *Hsu* does not disclose “*transmitting said component specification [...] as a data unit to a database,*” wherein the component specification “comprises at least one non-graphical data element representing a physical or functional attribute and at least one data element representing a non-physical and non-functional attribute.” In particular, *Hsu* does not disclose a component specification that includes a “non-graphical data element representing a physical or functional attribute.” Unlike the claimed embodiment, *Hsu* discloses storing data regarding a source object such as the text pattern and the object context (for example, a paragraph in a document).

Because the combination of *Loveland* and *Hsu* fails to teach or suggest each limitation of claim 1, Applicant asserts that claim 1 is patentable over the cited art under 35 USC 103(a). Thus, it is asserted that claim 1 is patentable over the cited art. Dependent claims 2-4 depend on claim 1, and should be patentable for at least the same reasons.

Independent claims 5, 6, 14, 18, 20, 24-26 each recite a limitation of transmitting or receiving a component specification as “a data unit” as discussed above. Thus, these claims should be patentable for the same reasons. Dependent claims 7-13, 15-17, 19 and 21-23 ultimately depend

on claims 6, 14, 18 and 20, and should be patentable as well in addition to the distinguishing limitations they recite.

VII. Conclusion

Based on the above amendments and these remarks, reconsideration of claims 1-26 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned agent by telephone.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, December 27, 2006.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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